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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,930	09/29/2003	Josef Dietl	24307-009001/2002P00240US	2375

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EXAMINER

HOMAYOUNMEHR, FARID

ART UNIT	PAPER NUMBER
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2439

NOTIFICATION DATE	DELIVERY MODE
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10/22/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PATDOCTC@fr.com

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/675,930	Applicant(s) DIETL, JOSEF	
	Examiner Farid Homayounmehr	Art Unit 2439	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10/14/09 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) ☐ They raise the issue of new matter (see NOTE below);
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
 5. ☐ Applicant's reply has overcome the following rejection(s): _____.
 6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
 The status of the claim(s) is (or will be) as follows:
 Claim(s) allowed: _____.
 Claim(s) objected to: _____.
 Claim(s) rejected: 3-6, 13-16 and 18-28.
 Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
 13. ☐ Other: _____.

/Edan Orgad/
 Supervisory Patent Examiner, Art Unit 2439

Farid Homayounmehr
 Examiner
 Art Unit: 2439

With regards to 101 rejection, applicant argues that the claims either transform an article of physical object to a different state or thing, or produce a useful, concrete and tangible result. Applicant specifically argues that the claims transform the text to a cononical form. However, the claims do not include the device that perform the printing. The claims are directed to a program, and the program at most initiates the command that performs the printing. Therefore, the claims do not include the device that performs the conversion and this does not make the claims statutory. The same can be said about rejected claims of this application including means to perform a function. The means is declared as software as per the specification. The printer or the physical; device that performs the printing is not part of the claim language. Therefore, said claims are not statutory.

With regards to rejection under section 103, applicant argues that elements of the claimed invention are not taught by Nord. Specifically, applicant argues:

Section A.1. Nord does not teach the "validating element. However, as explained in the rejection, Nord is cited to show simultaneously signing a digital and a printed version of the document. After the paper document is signed, it is scanned and placed in the system (see paragraphs, 5-12, 67-68, or the abstract). The rejection further explains that once the document is scanned into electronic form, Slater teaches the inclusion of verification codes and verifying the authenticity. Applicant's own section B shows which parts of Slater are cited to teach the element of "validating". Therefore, Slater in view of Shioda and Nord teaches the "Validation" element.

Section A.2. Nord does not teach "Integrating" element. However, as also indicated above, Nord teaches signing a paper and digital document. The feature of "integrating" elements is taught by the combination of Slater, Shioda and Nord, as explained in the rejections.

Section A.3. Applicant mentions other elements of claim, such as "generating control codes", and argues they are not taught by Nord. Once again, the rejection does not rely on Nord for those elements. The combination of cited prior arts teaches the claimed elements. The example element of generating control codes is taught by Slater in view of Shioda, as shown in the Final rejection.

Section B. Applicant argues that Slater does not teach the "validating" element. Applicant argues that Slater teaches away from using control codes for verifying a document because it involves reconstructing the document to a previous state. However, it is not clear why reconstructing a document to a previous state teaches away from using control codes for verification. In fact, Slater teaches control codes are the signature blocks added to document as described in parag. 29-32, which contains the signatures. Note that the digital signatures are encrypted (see Slater parag. 13, indicating that the digital signature is decrypted), and therefore the encrypted digital signature creates a control code for verification of the digital signature. Accordingly, Slater teaches the "validating" element.

Applicant's arguments relative to other claims are based on the same features discussed above. Accordingly, applicant's arguments are non-persuasive, and all rejections are maintained.